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No. 75-984

In the Supreme Court of the United States

OCTOBER TERM, 1975

MARY HELEN SEARS, PETITIONER

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

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Petitioner filed suit in the United States District Court for the Eastern District of Virginia, seeking disclosure under the Freedom of Information Act of all of the approximately 600,000 abandoned United States patent applications. The district court held (357 F. Supp. 1327) that abandoned patent applications are "specifically exempted from disclosure by statute," within the meaning of exemption 3 of the Act, 5 U.S.C. 552(b)(3), by 35 U.S.C. 122, which provides that "[a]pplications for patents shall be kept in confidence * * * unless necessary to carry out the provisions of an Act of Congress * * *."

The court of appeals affirmed (502 F.2d 122). Although the court of appeals gave exemption 3 only a narrow construction, it nevertheless concluded that 35 U.S.C. 122 exempts disclosure under that provision as narrowly construed.

Petitioner sought certiorari review in this Court. While her petition was pending, the Court in *Administrator, Federal Aviation Administration* v. *Robertson*, 422 U.S. 255, rejected the narrow construction given exemption 3 by various courts of appeals, holding that exemption 3 was intended "to permit the numerous laws then extant allowing confidentiality to stand" (422 U.S. at 266). The following week this Court denied certiorari in this case. 422 U.S. 1056. A petition for rehearing was denied on October 6, 1975 (No. 74-584).

On October 28, 1975, petitioner filed a motion in the district court, pursuant to Rule 60(b), Fed. R. Civ. P., seeking relief from the judgment. Petitioner argued that the decisions of the district court and the court of appeals in her case conflicted with *Robertson*. The district court dismissed the motion because petitioner had not sought leave from the court of appeals (Pet. App. 1a). Petitioner then requested the court of appeals to allow the district court to consider the motion. The court of appeals declined (Pet. App. 2a).

1. Petitioner incorrectly contends (Pet. 10-13) that this case presents the question whether leave of the court of appeals is required before a district court may consider a Rule 60(b) motion after an appellate decision. Petitioner did not appeal the district court's dismissal of the Rule 60(b) motion. Instead, she filed a motion requesting the court of appeals to give permission for the district court to consider the Rule 60(b) motion. Thus, the only question properly presented by the petition is whether the court of appeals was correct in denying the motion presented to it. Petitioner has not preserved the question whether leave of the court of appeals is required.[1]

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[1]Nor is it clear that the courts of appeals are in conflict. Petitioner accurately observes (Pet. 11-13) that most courts of appeals unambiguously require a party to apply to the court of appeals for leave to file in the district court a Rule 60(b) motion after the court of appeals has addressed the case on the merits. The Second Circuit has not yet passed upon the question. *Smith* v. *Alleghany Corp.*, 394 F.2d 381, 388. And the Tenth Circuit, which petitioner asserts does not require appellate leave (Pet. 10-11), has reconsidered its position. See *Pierce* v. *Cook & Co.*, 518 F.2d 720, 722 (*en banc*).

The prevailing rule, which requires appellate leave, prevents repetitious litigation and preserves the finality of judgments. It precludes unnecessary (and perhaps vexatious) litigation in the district court of issues that the court of appeals already has decided and is unwilling to reconsider. Allowing a Rule 60(b) motion in the district court as of right might be appropriate if the motion involved matters extrinsic to the court of appeals' previous judgment, but that is not the case here, for petitioner wages a direct assault upon the propriety of the court of appeals' legal conclusions.

2. Contrary to petitioner's contention (Pet. 13-16), the court of appeals' denial of her motion was proper. The court of appeals' earlier decision that 35 U.S.C. 122 exempts disclosure under exemption 3 is consistent with *Robertson*. As we have indicated, the court of appeals in reaching that decision had given petitioner the benefit of a narrower construction of exemption 3 than this Court subsequently held was proper in *Robertson*, where the Court rejected the restrictive interpretation that the court of appeals had given to exemption 3 and held that exemption 3 subsumes all existing confidentiality statutes. Since 35 U.S.C. 122 is such a confidentiality statute, the court of appeals' earlier judgment was correct under *Robertson*,[2] and explicit reconsideration in light of *Robertson* could not benefit petitioner.[3]

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[2]See *Robertson, supra*, 422 U.S. at 263, n. 6 (implicitly endorsing the court of appeals' holding with respect to 35 U.S.C. 122); *id.* at 269, n. 1 (Stewart, J., concurring).

[3]Petitioner appears to contend (Pet. 16-19) that the court of appeals, by denying petitioner's motion without argument, has in some way condoned an alleged evidentiary practice of the Patent Office. Petitioner does not, however, support that contention, which appears to have no legal or factual basis.

At bottom, petitioner simply seeks review of an issue on which this Court already has denied certiorari and rehearing — whether the disclosure bar of 35 U.S.C. 122 survived enactment of the Freedom of Information Act. That issue was settled by *Robertson*. Further review here is plainly unwarranted.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

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